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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/786,601	02/26/2004	Maximilian Arzberger	P69484US0	2823
7590	05/02/2006		EXAMINER	
Jacobson Holman Professional Limited Liability Company 400 Seventh Street, N.W. Washington, DC 20004-2218			PETRAVICK, MEREDITH C	
			ART UNIT	PAPER NUMBER
			3671	

DATE MAILED: 05/02/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/786,601	ARZBERGER, MAXIMILIAN	
	Examiner	Art Unit	
	Meredith C. Petrvick	3671	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 14 February 2006.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-3,5-11 and 14-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-3,5-11 and 14-17 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 9/14/2005 is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____.
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
	6) <input type="checkbox"/> Other: _____.

DETAILED ACTION

Drawings

1. Page 8 of the amendment filed on 9/14/2005 states that a replacement of Figure 1 was filed. However, no replacement drawings were found with the amendment.
2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the trench of rectangular cross-section, third and fourth cutting wheels and the second common rotation axis must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will

be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-3, 5-11 and 14-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bauer et al. 4,694,915 in view of Smith et al. 4,120,106.

Bauer et al. discloses a trench wall cutter, capable of cutting a rectangular cross-section trench, having four cutting wheels (11) below a frame (5). The cutter wheels are arranged into a first pair and a second pair, each having a common rotation axis. The rotation axes of the first and second pair are parallel (See Figs. 1 and 5). The wheels have cutters (Fig. 1).

However, Bauer et al. does not disclose any of the detail of the cutters nor making the cutters have two cutting elements on a control device so one cutting element removes soil when the wheels are rotated in a first direction while the second cutting element is retracted and the second cutting elements removes soil when the cutting wheels are rotated in a direction opposed to the first direction and the first cutting element is retracted.

Like Bauer et al., Smith et al. discloses a soil-cutting device having a rotating cutting wheel (58) with cutters attached. Unlike Bauer et al., Smith et al. discloses providing the cutters

with two cutting elements (108 and 106). The cutting elements are attached to a control device (60). The first cutting element (108) removes soil when the wheel is rotated in a first direction while the second cutting element (106) is retracted by the control device (6). The opposite happens when the wheel is rotated in a second direction. Smith et al. discloses that this allows the device is cut in multiple directions without wearing out the not used cutting element (Col. 1, line 60 – Col. 2, line 12).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to replace the cutters of Bauer et al. with the cutters of Smith et al., in order to provide for more efficient operation of the device in two directions as suggested in Smith et al.

Regarding claims 2-3 and 5, Smith et al. discloses that the first and second cutting elements are displaceable simultaneously by a force exerted by moving the device against the ground.

Regarding claims 6-8, Smith et al. discloses that the control device is a pivoted lever (60) that has a pivot axis (pivot pin 110) and is symmetrical about the pivot axis (Fig. 4).

Regarding claim 9, Smith et al. discloses that there is a pair of cutting elements on each pivoted lever (Fig. 4).

Regarding claim 10, Smith et al. discloses that the pivoted lever has stops (120, 118).

Regarding claim 11, Smith et al. discloses that the cutting elements have cutting edges (Fig. 4).

Regarding claims 14 and 15, the device in Bauer et al. discloses a frame (5), which is a support plate (Fig. 1) and has bearing plates (13).

Regarding claim 16, any one of the cutting teeth in the combination could be considered as the laterally pivotable hinged teeth, since they are laterally pivotable hinged and capable of removed soil below the bearing plates.

Response to Arguments

5. Applicant's arguments filed 2/14/2006 have been fully considered but they are not persuasive.

The declaration of Josef Haas has been considered.

In response to applicant's argument that applicant's argument that the combination is not obvious, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

In response to applicant's argument that the references are nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, both cutters are used to remove dirt and are classified in class 37.

Conclusion

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Meredith C. Petravick whose telephone number is 571-272-6995. The examiner can normally be reached on M-T 8:00 a.m.- 5:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas B. Will can be reached on 571-272-6998. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Meredith C Petrvick
Primary Examiner
Art Unit 3671

April 30, 2006